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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,879	09/16/2003	Richard R. Tidwell	421/60/10/2	3104
25297	7590	08/22/2007	EXAMINER	
JENKINS, WILSON, TAYLOR & HUNT, P. A. SUITE 1200, UNIVERSITY TOWER 3100 TOWER BOULEVARD DURHAM, NC 27707				WEBMAN, EDWARD J
ART UNIT		PAPER NUMBER		
		1616		
MAIL DATE		DELIVERY MODE		
		08/22/2007		
		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,879	TIDWELL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edward J. Webman	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 30 May 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 17-32 is/are pending in the application.
  - 4a) Of the above claim(s) 20-28, 30 is/are withdrawn from consideration.
- 5) Claim(s) 17-19, 29 and 31 is/are allowed.
- 6) Claim(s) 32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/21/07.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants provide no standard by which to determine prophylaxis.

Applicants argue that Wands factors have not been considered. However, applicants' claims are broad, the level of predictability is low, and there are no working examples, mitigating against enablement for the claimed prophylaxis. Applicants further argue that they believe that one of ordinary skill could, after reading the specification, follow a patient for a period of time to determine whether the claimed compounds reduce the likelihood of developing and being diagnosed with Alzheimer's disease in a subject predisposed to the disease. However, applicants' averment is mere opinion. Further, reducing the likelihood of developing the disease does not address the claimed prophylaxis, that is, the claimed prevention. Additionally, applicants do not explain how one of ordinary skill would determine which subjects would be predisposed to the disease nor how long the subject should be followed.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Nowhere in the specification do applicants provide evidence of prevention nor do they provide an experimental regime for determining such.

Applicants argue that the examiner has not identified that the logic underlying the assertion is seriously flawed or that the assertion is inconsistent with the logic underlying the assertion. Applicants assert that because  $I_2$  binding sites are upregulated in patients with Alzheimer's disease and that the claimed compounds bind tightly to such binding sites, that treatment of a patient with Alzheimer's disease with the compounds will prevent the disease. The underlying assumption is that upregulation of such sites causes the disease. However, upregulation could just as well be a result rather than a cause of the disease. Further, applicants stipulate that such upregulation is also caused by aging. Therefore, the upregulation may be caused by aging rather than the disease, the disease occurring in parallel to aging. Thus, applicants' logic underlying their assertion that upregulation of the sites is a cause of the disease is seriously flawed. Applicants hypothesize but have not demonstrated a link between administration of the claimed compounds and prevention of the disease.

Claim 32 is rejected. Claims 17-19, 29 and 31 are allowed. The non-elected species will be examined when all issues regarding the elected species are resolved.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Richter, can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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